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PAPER NO.

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**OCT 28 2004**

**OFFICE OF PETITIONS**

In re Application of :  
Tsien et al. :  
Application No. 10/866,538 : DECISION ON APPLICATION FOR  
Filed: May 24, 2001 : PATENT TERM ADJUSTMENT  
Atty Docket No. REGEN1530-2 :

This is a decision on the "PETITION TO CORRECT PATENT TERM ADJUSTMENT HISTORY UNDER 37 C.F.R. § 1.705(b)," filed July 2, 2004. Applicants request that the initial determination of patent term adjustment under 35 U.S.C. 154(b) be corrected from 19 days to 21 days.

The request for correction of the initial determination of patent term adjustment (PTA) is granted to the extent indicated herein. However, for the reasons stated, the determination of PTA at the time of the mailing of the notice of allowance is ZERO (0) days.

The Office has updated the PAIR screen to reflect that the correct Patent Term Adjustment determination at the time of the mailing of the Notice of Allowance was ZERO (0) days. A copy of the updated PAIR screen, showing the correct determination, is enclosed.

On April 7, 2004, the Office mailed the Determination of Patent Term Adjustment under 35 U.S.C. 154(b) in the above-identified application. The Notice stated that the patent term adjustment to date is 19 days. Applicants state that the delay attributed to applicants for failing to respond to the Notice to File Missing Parts of Application within two months should be 3 days, instead of 5 days. In support thereof, applicants submit their return stamped postcard showing a date of receipt of their response on September 28, 2001.

The record indicates that the patent issuing from this application is not subject to a terminal disclaimer.

A review of the application file reveals that applicants' response to the Notice to File Missing Parts of Application mailed July 25, 2001, is of record in the application with a date of receipt by the Office of September 28, 2001, reflecting timely filing<sup>1</sup> for purposes of compliance with 37 CFR 1.704(b). Applicants are reminded that the period, or shortened statutory

<sup>1</sup> Applicants' postcard receipt further provides *prima facie* evidence that the response was timely filed within the meaning of § 1.704(b). See MPEP 503.

period, for reply that is set in the Office action or notice has no effect on the three-month period set forth in § 1.704(b). See 37 CFR 1.704(b). It is of no consequence to the calculation of PTA that the response was received outside of the two-month period set in the Notice.

Moreover, the response was complete and proper. Thus, the Office should not have entered the date that the instant application was complete as October 30, 2001 or assessed applicants a delay of five (5) days. The response was timely filed within the three-month period under 37 CFR 1.704(b) and accordingly, applicants' delay should have been assessed as zero "0" days. Applicants did not fail to engage in reasonable efforts to conclude prosecution of the application by delaying in replying to the Notice to File Missing Parts of Application.

However, a review of the application history reveals that there are further grounds for reduction of the patent term adjustment. 37 C.F.R. § 1.704(c)(7) provides that:

Submission of a reply having an omission (§1.135(c))<sup>2</sup>, in which case the period of adjustment set forth in § 1.703 shall be reduced by the number of days, if any, beginning on the day after the date the reply having an omission was filed and ending on the date that the reply or other paper correcting the omission was filed.

In the instant case, an initial reply was filed on August 22, 2003. However, by Notice mailed September 4, 2003, applicants were advised that the reply was an informal or non-responsive amendment. On September 10, 2003, applicants filed a supplemental response, correcting the items deemed non-responsive by the examiner. Accordingly, the period of adjustment is 19 days, the number of days in the period beginning on August 23, 2003 and ending on September 10, 2003.

In addition, pursuant to 37 CFR § 1.704(c)(8), the submission of a supplemental reply or other paper, other than a supplemental reply or other paper expressly requested by the examiner, after a reply has been filed, is a failure to engage in reasonable efforts to conclude prosecution. After filing the supplemental response on September 10, 2003, applicants filed an IDS on October 31, 2003. The record does not support a conclusion that this IDS was expressly requested by the examiner. Nor is the IDS accompanied by a § 1.704(d) statement. Accordingly, the PTA should be reduced by 51 days, the number of days beginning on the day after the date the reply was filed, September 11, 2003, and ending on the date that the supplemental reply or other such paper was filed, October 31, 2003 for the filing of the IDS.

In view thereof, the correct determination of PTA at the time of the mailing of the notice of allowance is ZERO (0) days (including a period of reduction of 114 days).

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<sup>2</sup> §1.135(c) When reply by the applicant is a bona fide attempt to advance the application to final action, and is substantially a complete reply to the non-final Office action, but consideration of some matter or compliance with some requirement has been inadvertently omitted, applicant may be given a new time period for reply under § 1.134 to supply the omission.

The Office acknowledges submission of the \$200.00 fee set forth in 37 CFR 1.18(e). No additional fees are required.

The Office of Patent Publication has been advised of this decision. The application has, thereby, been forwarded for issuance.

Telephone inquiries specific to this matter should be directed to Nancy Johnson, Senior Petitions Attorney, at (571) 272 - 3219.

*Karin Ferriter*

*for*  
Karin Ferriter  
Senior Legal Advisor  
Office of Patent Legal Administration  
Office of Deputy Commissioner  
for Patent Examination Policy

Enclosure: Copy of adjusted PAIR calculation